

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claim 1 is amended. Claims 1-10 are pending in this application. Claims 1 and 7 are independent claims.

Claim for Priority

It is gratefully acknowledged that the Examiner has, (in the Office Action dated October 2, 2002), recognized the Applicant's claim for foreign priority. In view of the fact that the Applicant's claim for foreign priority has been perfected, no additional action is required from the Applicant at this time.

Drawings

The Official Draftsperson has not rendered an opinion regarding the Formal Drawings submitted by the Applicant since not PTO-948 form has been received. It is respectfully submitted that the drawings comply with the requirements of the USPTO. If the Official Draftsperson has any objections to the Formal Drawings he is respectfully requested to contact the undersigned as soon as possible so that appropriate action may be taken. No further action is believed to be necessary at this time unless the undersigned receives a notice from the Official Draftsperson.

Acknowledgment of Information Disclosure Statement

The Examiner has acknowledged the Information Disclosure Statement filed on July 10 and September 25, 2003. Initialed copies of the PTO-1449s have been received from the Examiner. No further action is necessary at this time.

The Subject Matter of the Present Application

The present application is generally directed to an apparatus wherein an eye can be indicated by an operator and a red eye state can be easily confirmed by an image with high resolution. In conventional apparatuses, the operator is required to take out an eye from the image and the verification thereof is performed using data of low resolution making it difficult to confirm a red eye state. In the present invention, an image processing apparatus includes a display for displaying the image carried by the image data at high resolution or low resolution. A display switching means switches at least one portion or all portions of the image displayed from the low resolution to the high resolution and vice versa. The switching means switches in such a way that at least the region designated in the image is displayed at high resolution before or after, or both before and after the region is processed by the red eye correction means.

Rejection Under 35 U.S.C. § 103(a)

Claims 1 and 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stokes et al. in view of Leone et al. Applicant respectfully traverses this rejection.

It is noted that while the Examiner has applied a new grounds of rejection, the Examiner is still using the same references previously used in the initial Office Action. In supporting the present rejections, the Examiner has utilized Stokes et al. for the main reference and Leone et al. as a secondary reference with Yamanouchi following as a third reference.

Regarding the newly applied rejection against independent claim 1, Applicant respectfully submits that the Examiner has still failed to establish a *prima facie* case of obviousness.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir.

1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

Stokes et al. utilizes low and high resolution image data. However, Stokes et al. is only concerned with performing a quality check on the scanned image. In other words, no type of quality or red eye correction is disclosed. Stokes et al. does not care about red eye and thus has no system for red eye. Stokes et al. only allows a selected portion of a scanned image to be subsequently scanned at high resolution so that the quality of the image can be checked. In other words, there is no teaching or suggestion for more than one sample being scanned nor is there a need in Stokes et al. to provide red eye correction.

More particularly, Stokes et al. teaches that after selecting a predetermined portion in a low resolution image displayed on the display screen (window), the image is then scanned at high resolution to display the high resolution image in the selected portion on the display screen. And if the displayed portion of the high resolution image is of acceptable quality, the high resolution scanning will continue until completion. On the other hand, if the displayed image portion has an unacceptable image quality, the high resolution scanning process will be instantly terminated. Thus, Stokes only utilizes the high resolution image portion on the display screen to check for the quality of high resolution scanning. The high resolution image in Stokes is not subjected to any image processing. Instead,

the high resolution image portion is merely viewed by a user for a subjective check of quality.

It is further emphasized that, in Stokes, only a portion of the high resolution image is actually scanned for the human quality check and that the high resolution scan is not completed if the human determines that there is not an acceptable quality in the portion already scanned.

In contrast, in the present invention, both the low resolution image data and the high resolution image data are previously read out by the image read means such as a scanner to be stored in a memory device. The low resolution image and the high resolution image displayed on the display correspond respectively to the low resolution image data and the high resolution image data each of which is read out from the memory in which these data are previously stored.

This distinction is emphasized in the above amendments. Specifically, the image processing apparatus of claim 1 has been amended to further recite a storage means. This claimed storage means stores the image data at high resolution that is finely scanned and the image data at low resolution that is pre-scanned. Thus, the claimed apparatus requires storage of both the high and low resolution image data, a fact which is clearly not true of Stokes.

Previously storing the high and low resolution image data in a storage means, as claimed, provides a distinct advantage also not found in Stokes. Namely, the previous storage of this data permits the switching between the high and low resolution images. This is further recited in claim 1 as a display switching

means that switches at least one portion or all portions of the image displayed from the low resolution to the high resolution and vice versa. This is simply not possible in Stokes.

The present invention is further distinguished from the applied art by the designation means, particularly taken in combination with the display and storage means further recited in claim 1. Specifically, the present invention designates a region including an eye in the low resolution image using the claimed designation means. The designated region designated by designation means in the low resolution image is utilized by the red eye correction means to correct the red eye effect. In other words, the image is subjected to red eye correction by the red eye correction means based on the high resolution output image data. At some other time (either prior to, or after, or both prior to and after the red eye correction) the high resolution image is displayed on the display. Depending upon the timing, the high resolution image permits the operator to determine if the red eye correction has been successful.

As argued above, Stokes simple does not disclose or suggest that the low and high resolution image data are both previously stored in the storing means. Even if it did suggest such a feature, Stokes certainly does not disclose or suggest that a red eye correcting is performed based on the high resolution image data and that the high resolution image, after the correction, may then be displayed. It is simply not seen how a human review of a portion of a high resolution image (which is not previously stored) can somehow teach or suggest the specific

features of a storage means, display, display switching means, designation means and red eye correction means as more specifically recited in amended claim 1.

Indeed, Stokes et al. must be considered in its entirety including disclosures that teach away from the claimed invention. *See M.P.E.P. 2142.02*. If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. *See M.P.E.P. 2143.01*. Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection must fail.

Leone et al. discloses a scanning of a photograph to receive a first resolution which is not categorized as either low or high resolution. This is one scan only. Leone et al. uses the same scan again to get a subsample and this subsample is used to create an even lower resolution image data. To correct a "red-eye" condition, Leone et al. activates a conventional process for correcting the artifact condition by touching an applied button 18. There is nothing new or unique in the correction of "red-eye" as set forth by Leone et al., in column 4, lines 23-36.

More particularly, Leone discloses selecting a particular position in the displayed image to zoom-in and zoom-out and further to pan, undo, and to further make red eye correction to a particular portion having a center of a predetermined value designated from the displayed image. Nevertheless, the zoom-in and zoom-out functions are performed by Leone merely by subsampling the image data of

the source image. Thus, a single scanned image may be processed by Leone to perform zoom-in and zoom-out.

This is quite distinct from and does not disclose or suggest the claimed switching between two different display images, the low resolution image data and the high resolution image data that are read by a scanner or the like. Indeed, the concept of two separately scanned images is now explicitly recited in amended independent claim 1, at least in the storage means which stores high resolution image data that is finely scanned and low resolution image data that is prescanned. This requires two separate scannings, a fact which is clearly absent from Leone.

Moreover, there is no motivation to combine Leone and Stokes. As noted above, Stokes' primary object is to obtain two kinds of read (scanned) image data and displays a portion of the high resolution image to check the quality thereof but fails to disclose a storing means for previously storing two kinds of scanned image data. Nor does Stokes teach or suggest displaying the high resolution image data corresponding to the image data read out from a storage means nor any image processing such as red eye correction or otherwise. Still further, Leone merely discloses utilizing a single scanned image as a source to perform red eye correction and merely subsamples the single red out image data with a different frequency to thereby zoom-in or zoom-out at a predetermined point. As such, Leone also fails to disclose or suggest a storing means for previously storing two kinds of read out image data as further recited in amended independent claim 1.

Thus, it is apparent that the present invention and the proposed combination of Stokes and Leone have clear distinctions from each other. Furthermore, there is no motivation to combine these references. Even if these references were combined as the Office Action suggests, the proposed combination would still not teach or suggest the present invention. Therefore, the obviousness rejection clearly must fail and Applicant respectfully request reconsideration and withdrawal thereof.

In this instance, it appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight. *See MPEP 2141*. Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. *See MPEP 2143*.

Since, Stokes et al. does not teach the red eye correction means for correcting a red eye effect by subjecting the output image data of the eye in the region designated by said designation means to eye color transformation processing, as recited in independent claim 1, Stokes et al. is not a valid reference.

The Examiner offers no motivation why Stokes et al. would look to Leone et al. for "red-eye" correction. Stokes et al. does not even care about "red-eye" correction and uses two scans: one for high and one for low. In complete contrast, Leone et al. uses one scan and then subsamples this scan to do a simple red-eye correction. Surely, the Examiner does not suggest that one of ordinary skill in the art would look to Stokes et al. with two scans and no "red-eye"

correction and decide, with no motivation to combine, that red-eye correction of Leone et al. is necessary. Of course, Stokes et al. would have to be used for something not contemplated. The two scans of Stokes et al. would have to be eliminated along with the corresponding components and a new system would have to be made with one scan and a subsample of that scan together with a new red-eye correction circuit implemented. It is respectfully submitted that such a combination is not permissible.

Recent Federal Circuit case law precedent makes it explicitly clear that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, but must be read on the objective evidence of the record. Federal Circuit case law precedent further requires that "common sense and common knowledge" alone is improper evidence in support of an obviousness rejection.

The Examiner purports a common sense and common knowledge reason for the deficiencies of Stokes et al., in other words, stating that Stokes et al. would have suggested a similar technique. However, common sense and knowledge are not objective evidence of record, as the Federal Circuit explains, but are in fact commensurate with subjective belief and unknown authority. Therefore, the Examiner has failed to meet the legal requirements to substantiate the obviousness rejection.

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the recent Federal Circuit decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002).

In re Lee involved an appeal of a decision of the Board of Patent Appeals in which *Lee* argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *Id.* at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the administrative procedure act." *Id.* at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[t]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." *Id.* at 1433. The Court also stated that the USPTO is "not free to refuse to follow Circuit precedent" and "cannot rely on conclusionary statements when dealing with particular combinations of prior art and specific claims." *Id.* at 1434.

As stated herein above, the Examiner's asserted modification for Stokes et al., which is that "Stokes [et al.] teaches that upon reviewing an unacceptable image, the high resolution scan can be canceled" still does not overcome and the lack of factual support thereof comports very closely to the analysis disapproved

by the Federal Circuit in *In re Lee*. As such, the Examiner's failure to provide factual support for a teaching, suggestion or motivation to modify Stokes et al. constitutes legal error.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1 and 7-10 under 35 U.S.C. §103(a) based on Stokes et al. and Leone et al. for at least the above-noted reasons.

Dependent claims 2-5

Claims 2-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stokes et al. in view of Leone et al. and in further view of U.S. Patent No. 5,420,699 to Yamanouchi et al. Applicant respectfully traverses this rejection.

Claims 2-5 depend directly or indirectly from independent claim 1. Therefore, these dependent claims are also distinguishable over the combination of Stokes et al. and Leone et al. for at least the reasons stated with respect to the independent claim.

Additionally, for a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P. 2143.01*.

It is respectfully submitted that Yamanouchi et al. is directed to a processing machine to process information recorded on photographic film. It is

unclear as to the relevance of this patent with respect to the claimed invention except for that there are bits and pieces of similar cited features with respect to the dependent claims. However, Yamanouchi et al. does not solve the shortcomings of Stokes et al. or Leone et al.

Applicant respectfully submits that the combination of Stokes et al. and Leone et al and/or the combination of Stokes et al., Leone et al. and Yamanouchi et al. fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claim 1 is allowable over the cited references for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-10 under 35 U.S.C. §103(a) is respectfully solicited.

Dependent Claim 6

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stokes, Leone, Yamanouchi and further in view of DeLuca. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Claim 6 directly depends from independent claim 1. Therefore, this dependent claim is also distinguishable over the combination of the reference for at least the reasons stated above with respect to independent claim 1.

It is also respectfully submitted that DeLuca fails to remedy any of the noted deficiencies in the base combination of Stokes, Leone, and Yamanouchi. In any event, DeLuca is applied to teach the features of dependent claim 6. Applicant wishes to focus the patentability of this invention upon independent claim 1 but reserves the right to argue dependent claims' features in the future if necessary. Since patentability is clearly established as to independent claim 1 and the base combination of Stokes and Leon, such arguments are not deemed to be necessary at this time. In any event, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103 Stoke-Leone-Yamanouchi-DeLuca rejection.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$950.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the

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undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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